

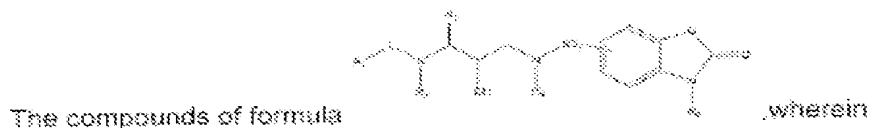
## **REMARKS**

Claims 1-9 and 12-19 are currently pending. Claims 7-9, 13-15, and 16-19 are withdrawn for further consideration by Applicant as being drawn to a non-elected invention. Thus, claims 1-6, 12 and 16 are currently under examination. Claims 1 is hereby amended without disclaimer of or prejudice to the subject matter deleted.

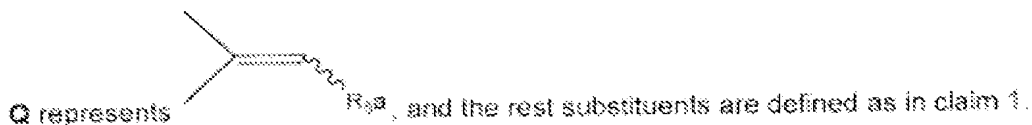
### **Scope of the Claims**

Applicant respectfully asserts that the Examiner has improperly narrowed the scope of the election, based on an election which Applicant did not in fact make. Specifically, the Examiner states at pages 3-4 of the present Office Action:

The scope of the invention of the elected subject matter is as follows:

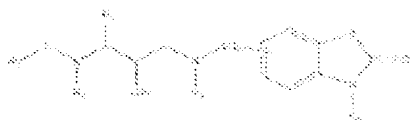


R<sub>4</sub> is H, or C<sub>1-6</sub>alkyl;



(Office Action mailed March 16, 2006 at pages 3-4.)

In fact, Applicants elected the entirety of Group I, which in the prior Office Action mailed January 18, 2006, is described as:



, and a pharmaceutical composition, wherein the substituents are claimed in claim 1 or 2. If this group is elected, Applicant is requested to elect a single species for search purposes. This group is subject to further restriction, if elected.

(Office Action mailed January 18, 2006 at page 3.)

The Examiner states on page 4 of the present Office Action:

As a result of the election and the corresponding scope of the invention identified supra, the remaining subject matter of claims 1-5, 12, and 16 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn compounds contain varying functional, which are chemically recognized to differ in structure and function. Therefore the subject matter which are withdrawn from consideration as being non-elected subject differ materially in structure and composition and have been restricted properly a reference which anticipated but the elected subject matter would not even render obvious the withdrawn subject matter and the fields of search are not co-extensive.

(Office Action mailed March 16, 2006 at page 4.)

**Applicant asserts that no subject matter of claims 1-6, 12 and 16 has been withdrawn by Applicant. Applicant requests full consideration of the entire scope of the elected invention (Group I), which is the full scope of claims 1-16, 12 and 16.**

To the extent that the Examiner is now applying a further restriction, Applicant requests clarification (see MPEP 814) and an opportunity to respond and elect within the further restricted groups.

**Oath/Declaration**

The Examiner has rejected the submitted Declaration for failing to properly identify the citizenship of each inventor. Specifically, the Examiner states:

***Oath/Declaration***

It does not identify properly the citizenship of each inventor. Abbreviation of the citizenship of each inventor "MA" or "BE" is not acceptable. Appropriate correction is required.

(Office Action mailed March 16, 2006 at page 4.)

Applicant respectfully points out that the abbreviations "MA" (for Morocco) and "BE" (for Belgium) used in the Declaration, to which the Examiner objects, are the PCT Country codes which the PCT Applicant's Guide – Volume I – Annex K states are appropriate for use in international applications filed pursuant to the PCT, as was the present application:

PCT Applicant's Guide – Volume I – Annex K

Page 1

**K**

**Country Names and Two-Letter Codes**

**K**

Annex K includes a list of short names and two-letter codes accepted for use in indicating States, other entities and intergovernmental organizations (and their Offices) in documents relating to international applications under the PCT. The list is as set out in WIPO Standard ST.3 (see List of WIPO Standards, Recommendations and Guidelines on the web site at: <http://www.wipo.int/sci/en/standards/standards.html>).

Attached is a complete copy of PCT Applicant's Guide, Volume I, Annex K.

**Accordingly, Applicant respectfully requests reconsideration of the rejection of the Oath/Declaration in the present application.**

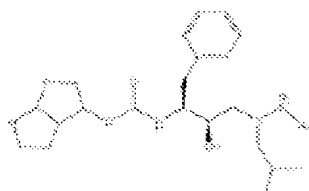
To the extent that the Examiner maintains the rejection of the Oath/Declaration, Applicant respectfully requests clarification as to the basis for the rejection. As Applicant finds that in the legal requirements of an Oath or Declaration (see 35 U.S.C. § 115, and 37 C.F.R. 1.63), identification of the country of citizenship of each inventor – “without abbreviation” is not a requirement. In contrast, “without abbreviation” is a requirement for the identification of each inventor by name, but not for citizenship. Compare 37 C.F.R. 1.63(a)(2) (“Identify each inventor by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial;”) with 37 C.F.R. 1.63(a)(3) (“Identify the country of citizenship of each inventor;”).

### **Claim Rejections – 35 U.S.C. § 103**

The Examiner has rejected claims 1-6, 12 and 16 under 35 U.S.C. § 103 as being unpatentable over WO 99/67254, which the Examiner describes as disclosing the following class of compounds:

#### *Determination of the scope and content of the prior art (MPEP §2141.01)*

Erickson *et al.* WO 99/67254 teach a class of compounds with a general



structure of

wherein one of  $R_4$  is an optionally substituted

heterocaryl such as indole as defined on page 19 of the specification and a

pharmaceutical composition which comprises the said compound as retroviral protease inhibitor.

(Office Action mailed March 16, 2006 at pages 5-7.)

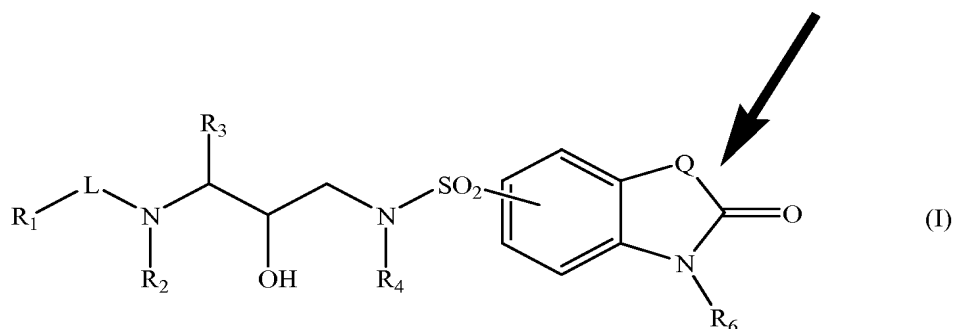
WO 99/67254 discloses a series of compounds which do include an optionally substituted indole group for use as a retroviral protease inhibitor. However, the suggested substitutions do not include a keto group:

The term "heteroaryl" means a radical defined by an aromatic heterocyclic ring as commonly understood in the art, including monocyclic radicals such as, for example, imidazole, thiazole, pyrazole, pyrrole, furane, pyrazoline, thiophene, oxazole, isoxazol, pyridine, pyridone, pyrimidine, pyrazine, and triazine radicals, and also including polycyclics such as, for example, quinoline, isoquinoline, indole, and benzothiazole radicals, which heteroaryl radicals are optionally substituted with one or more substituents selected from the group consisting of a halogen, an alkyl, alkoxy, amino, cyano, nitro, and the like. It will be appreciated that the heterocycloalkyl and heteroaryl substituents can be coupled to the compounds of the present invention via a heteroatom, such as nitrogen (e.g., 1-imidazolyl).

WO 99/67254 at page 20.

Applicant respectfully assert that one skilled in the art would not find the invention of the present application -- compounds of a chemically distinct pharmacophore, which WO 99/67254 does not disclose, teach or suggest, obvious over WO 99/67254.

Specifically, the present invention requires an indol-2-one group -- not an indole:



WO 99/67254 neither teaches nor suggests the addition of a keto group to the indole, and the introduction of such the keto group is not obvious from the disclosure of WO 99/67254. The possible substitutions listed in WO 99/67254 do not include a ketone:

including polycyclics such as, for example, quinoline, isoquinoline, indole, and benzothiazole radicals, which heteroaryl radicals are optionally substituted with one or more substituents selected from the group consisting of a halogen, an alkyl, alkoxy, amino, cyano, nitro, and the like. It will be appreciated that the heterocycloalkyl and

WO 99/67254 at page 20.

The presence of the ketone group in the pharmacophores of the present invention effects the molecular interaction capacities of the compounds of the present invention towards their target structure.

Accordingly, the pharmacophore of the present invention, the indol-2-one group that is not disclosed, nor taught or suggested in any way by WO 99/67254, and is not obvious from the disclosure of WO 99/67254.

Applicant respectfully requests removal of the rejection of claims 1-6, 12 and 16 under 35 U.S.C. § 103 as being unpatentable over WO 99/67254.

**Claim Rejections – 35 U.S.C. § 112, second paragraph**

The Examiner has rejected claims 1 and 8 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner states:

Cir. 1999). The term "combating" in claim 8 is indefinite because the specification does not clearly redefine the term. Deleting this term is suggested, since "treat" has been included in the claims 8.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "metabolite" is not defined by the claim, and the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Deleting this term is suggested.

(Office Action mailed March 16, 2006 at pages 7-8.)

Applicant respectfully disagrees with the Examiner's assertions regarding claim 1. However, in the interests of expediting issuance of patent, Applicant currently amends claim 1 to delete the phrase at issue. Applicant does so without disclaimer of or prejudice to the subject matter deleted.

Applicant notes that claim 8 has been withdrawn from consideration and, to the extent that the Examiner wishes to maintain the objection to claim 8, requests clarification as to why an objection to a withdrawn claim is being presented.

[Remainder of Page Blank]

**Conclusion**

Claims 1-6, 12 and 16 are believed to be in condition for allowance, early notice of which is respectfully requested.

Respectfully submitted,

/Alana G. Kriegsman/

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Dated: September 18, 2006

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**Attached:**

PCT Applicant's Guide – Volume I – Annex K (version 24 August 2006) (10 pages)